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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,144	08/05/2005	Hirotsugu Kinoshita	07481.0036-00000	9210

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EXAMINER

GOLOBOY, JAMES C

ART UNIT	PAPER NUMBER
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1714

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08/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,144	Applicant(s) KINOSHITA ET AL.	
	Examiner James Goloboy	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/5/05 & 3/15/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4, and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/512,584. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of the '584 application discloses a grease composition comprising a base oil, a urea-based thickener as in claims 1(a) and 4 of the current application, and a phosphorus compound as in claims 1(b) and 6 of the current application. The thickener of the '584 application is present in an amount of between 5 and 30% by weight,

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strongly overlapping the range recited in claim 1(a) of the current application, and the phosphorus compound is present in an amount of between 0.1 and 15% by weight, encompassing the range recited in claim 1(b) and matching the 0.1% endpoint. The difference between the claims of the '584 application and the current application is that the '584 application does not disclose specific phosphorus compounds having the structure recited in claim 1(b) of the current application.

Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). On page 12 lines 19-21 and page 13 lines 1-11 of the specification of the '584 application, it is taught that "phosphorus compounds" can be phosphate esters such as phosphates, meeting the limitations of claims 1(b) and 6. Therefore, it would have been obvious to one of ordinary skill in the art to use a phosphate as the phosphorus compound in claim 1 of the '584 application, meeting the limitations of claims 1, 4, and 6 of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1, 4, and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/590,775. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 1-2 of the '775 application disclose a grease composition comprising a base oil, a thickener as in claim 1(a) of the current application, an organomolybdenum compound as in claim 2 of the current application, and a phosphorus-based extreme pressure agent. The difference between the claims of the '775 application and the currently presented claims are that the '775 application do not disclose a specific extreme pressure agent, nor do the claims of the '775 application disclose the concentrations of the thickener and extreme pressure agent.

Applicant's attention is drawn to M.P.E.P. § 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F. 2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F. 2d 438, 164 USPQ 619, 622 (CCPA 1970). In paragraphs 76-77 of the specification of the '775 application, it is taught that phosphorus-based extreme pressure additives can be phosphate esters such as phosphates, meeting the limitations of claims 1(b) and 6. In paragraph 87 it is taught that the phosphorus-based extreme pressure additives are used in an amount of 0.1 to 5% by weight, falling within

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the range recited in the current claim 1(b), and in paragraph 36 it is taught that the concentration of the urea-based thickener is between 2 and 30% by weight, matching the range recited in the current claim 1(a). Therefore, it would have been obvious to one of ordinary skill in the art to use a phosphate as the phosphorus compound in claim 1 of the '775 application, and to use the phosphate and the thickener in the concentrations taught in the '775 application, meeting the limitations of claims 1-2, 4, and 6 of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita (U.S. Pat. No. 5,462,683).

In column 31 lines 18-31 (Example 6), Kinoshita discloses a grease composition containing 7.5% by weight of a lithium soap thickener, meeting the limitations of claims 1(a) and 3, 1.0% by weight of tributylphosphites, meeting claims 1(b) and 6 where the phosphorus compound has structure (1), and 3.0% by weight of molybdenum dithiocarbamate, and organic molybdenum compound meeting the limitations of claim 2.

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In column 31 lines 34-48 (Example 7), Kinoshita discloses a grease where tricresylphosphate, meeting claims 1(b) and 6 where the phosphorus compound has structure (2), is present. In column 2 lines 41-43, Kinoshita teaches that urea-based compounds, as in claim 4, are also preferred thickeners, and from column 2 line 57 through column 3 line 10 (including structure I), teaches that a urea based thickener meeting the limitations of claim 5 is preferable.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi (U.S. Pat. No. 5,516,439).

In column 2 lines 10-17, Takeuchi discloses a grease comprising a base oil, a lithium soap, an organic molybdenum compound, and a zinc dithiophosphate. Zinc dithiophosphate is a metal salt of phosphorus compound meeting structure (2) of claim 1(b). In column 4 lines 32-34 Takeuchi teaches that the thickener is present in an amount of 2 to 15% by weight, falling within the range recited in claim 1(a) and matching the 2% endpoint. In column 4 lines 36-38, Takeuchi teaches that the zinc dithiophosphate is present in an amount of 0.5 to 5% by weight, within the range recited in claim 1(b). The grease of Takeuchi therefore meets the limitations of claims 1-3.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kinoshita (U.S. Pat. No. 5,569,643) discloses grease compositions similar to those discussed in the rejections set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

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